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DEC 16 2005

**OFFICE OF PETITIONS**

In re Application of	:
Jian Ni et al	:
Application No. 09/933,767	: DECISION ON PETITION
Filed: August 22, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. PZ007P2	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed September 20, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed PCT Application No. PCT/US98/11422, filed June 4, 1998, as set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

It is noted in reviewing the chain of provisional applications to which PCT Application No. PCT/US98/11422 claims priority, it appears from Office database computer records that some of

the applications in the chain were not previously referenced or claimed in the PCT application. Petitioner is advised that, where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP Section 201.06(d). Therefore, the claim for priority to all the provisional applications cannot be accepted.

The petition is further not grantable since Application No. PCT/US98/11422 is claiming priority to two provisional applications which were filed after the filing of the PCT application; namely, the PCT application was filed on June 4, 1998, yet claims benefit of priority to provisional Application Nos. 60/092,921 (filed July 15, 1998) and 60/094,657 (filed July 30, 1998). A claim for priority can only be made to those applications filed prior to the filing date of the later-filed application. Accordingly, the amendment is not acceptable as filed.

Additionally, it is noted that the amendment contains duplicate entries; i.e., item numbers 76, 77, 78 are duplicates of item numbers 73, 74 and 75.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a proper amendment<sup>1</sup> along with a renewed petition under 37 CFR 1.78(a)(3), is required.

Further correspondence with respect to this matter should be addressed as follows:

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<sup>1</sup> Note 37 CFR 1.121

Any questions concerning this matter may be directed to Wan Laymon at (571) 272-3220.

A handwritten signature in black ink, reading "Frances Hicks". The signature is written in a cursive style with a large initial "F" and a long, sweeping underline.

Frances Hicks  
Lead Petitions Examiner  
Office of Petitions